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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,915	01/17/2001	Yasuo Tano	4084-2163	5564

21888 7590 12/03/2002

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EXAMINER

BUI, VY Q

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/761,915

Applicant(s)

TANO ET AL.

Examiner

Vy Q. Bui

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3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

# 6

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9-15 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Amendment dated 4/10/1998.

## **DETAILED ACTION**

### ***Drawings***

New corrected drawings are required in this application because the drawings are amended according to the "Proposed Amendments to the Drawings" filed 01/17/2001 as paper #2. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by "application number" and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The original "Oath and Declaration" does not state that " All errors being corrected arose without deceptive intention". Further, the original "Oath and Declaration" was amended (1/17/2001) after the inventors had been signed the "Oath and Declaration" (10/22/2000)- see MPEP 601.05.

A new and correct "Supplemental Oath and Declaration" must be filed stating that "all errors not covered by an "Oath and Declaration" arose without deceptive intention".

***Claim Rejections - 35 USC § 251***

Claims **1, 9, 12, 21** and dependent claims **2-7, 10-11, 13-15, and 22-25** are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claim 1 (application 09/058,183) was amended to recite **(I). "a hollow tapered front tip"** and **(II). "grains are located in arrange of 0.5mm to 3.0mm from an en portion of said front tip"** to overcome the 102 (b) rejection entered on 12/04/1998 (application 09/058,183) as being anticipated by SHIMIZU (U. S. Pat. 3,809,101). In the argument filed 04/10/1998 (from line 13, page 5 to line 4, page 6 of **attached Amendment A/#6, dated April 10, 1998**), the applicants argued that SHIMIZU does not disclose the features **(I)** and **(II)** above, and therefore, amended claim 1 was clearly

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defined over SHIMIZU. The amendment and argument was presented to obviate the rejection and was convincing, therefore the amended claim 1 was allowed and issued in U.S. Pat. 5,921,998 (column 6, lines 8, and 11-12, U.S. Pat. 5,921,998). See MPEP 1412.02.

The omission of the features (I) and (II) above in the independent claims **1, 9, 12, and 21** of the current application presents an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



VQB  
October 28, 2002.

Claim 2, line 2, change "is made from" to --comprise--.

Claim 3, line 2, change "are" to --comprise--.

Claim 4, line 2, change "are" to --comprise--.

Claim 5, line 2, change "is made from" to --comprises--.

Claim 6, line 2, after "adhesive" insert --to said front tip--.

#### IN THE ABSTRACT OF THE DISCLOSURE

Page 12, line 2, delete in its entirety.

line 3, delete in its entirety and insert --An instrument for removing

94 proliferative--;

line 4, change "disorders." to --disorders includes--;

line 5, delete "The invention is directed to";

line 6, change "comprises" to -- the tool including--.

#### REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1 and 4 have been rejected under 35 U.S.C. §102 as being anticipated under Shimizu; Claims 2-3 have been rejected under 35 U.S.C. §103 as being unpatentable over Shimizu in view of Calhoun; Claim 6 has been rejected under 35 U.S.C. §103 as being unpatentable over Shimizu in view of Takahashi et al and Claim 5 has been rejected under 35 U.S.C. §103 as being unpatentable over Shimizu in view of Morcher et al. Claims 1-6 remain active.

The present invention is directed to an instrument for removing proliferative membranes in a treatment for proliferative vitreoretinal disorders including an ophthalmic treatment tool for using in a ophthalmic surgery wherein the tool includes a grip portion, a rod-shaped body attached to one end of the grip portion, an elastic body fitted along a direction toward a front end of the rod-shaped body to the front end side of the rod-shaped body and a plurality of hard inorganic fine-grains or particles fixed on a tapered tip of the elastic body.

As can be appreciated from review of Figures 1a, 1b, and 1c and a review of pages 7-8 of the specification, the hard inorganic fine grains are fixed on the tapered front end of the elastic body and are located in a range of 0.5 mm to 3.0 mm from a tip end of the front end portion of the front tip and the elastic body has a hollowed tapered front tip for the evacuation of that portion of the membrane removed by the inorganic fine-grains.

3 Considering first then the rejection of Claim 1 and 4 under 35 U.S.C. §102 as being anticipated by Shimizu, it is noted that Claim 1 has been properly amended so as to be more closely directed to a membrane eraser used for ophthalmic surgery. More particularly, the membrane eraser is claimed as including an elastic body having a hollowed tapered front tip in combination with a plurality of hard inorganic fine-grains fixed on a tapered front tip of the elastic member where the grains are located in a range of 0.5 mm to 3.0 mm from a tip-end portion of the front tip. This is clearly distinguished from the nail file filing an individual's nails as shown in Shimizu which neither comprises a hollow tapered front tip of an elastic body nor does the same teach limiting the location of the grains to the range presently claimed and instead teaches only the utilization of an abrasive sheet 9 which extends substantially the entire length of the holding member of two connecting portions 6, as best

illustrated in each of Figures 2B and 3B thereof. In view of the foregoing, it is respectfully submitted that Claim 1 clearly patently defines over the Shimizu and that Claim 4, based both upon the limitations set forth therein and based upon the dependency of Claim 4 from Claim 1, also merits indication of allowability.

Considering next the rejection of Claims 2-3 under 35 U.S.C. §103 as being unpatentable over Shimizu in view of Calhoun, the rejection of Claim 6 under 35 U.S.C. §103 as being unpatentable over Shimizu in view of Takahashi et al and the rejection of Claim 5 under 35 U.S.C. §103 as being unpatentable over Shimizu in view of Morcher et al, it is respectfully submitted that none of the above-noted secondary references teach or disclose Applicants' claimed inventions, as now amended. More particularly, Calhoun, Takahashi et al and Morcher each do not teach an elastic body having a hollow tapered front tip or teach that a plurality of inorganic fine-grains are fixed on a tapered front tip of the elastic body wherein the grains are located in a range of 0.5 mm to 3.0 mm from a tip end portion of the front tip. The failure of these references to teach or disclose these limitations can be readily understood from a review of Calhoun which is directed merely to an abrasive article having a lateral spacing between abrasive composite members while Takahashi et al only teaches an endoscope having a combination urging and covering member that not only covers the outer circumferential portion of a flexible tube but which also urges the flexible tube in a manner to be secured to a first tapered portion. Lastly, it is noted that Morcher only teaches an intraocular lens and method for implanting the same in a posterior chamber of an eye having a posterior capsule.

Applicants further submit that, due to the different structure and functioning of each of Calhoun, Takahashi et al, and Morcher et al, these references would clearly not be

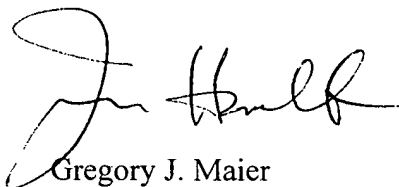


obviously combinable with the nail file shown in Shimizu and, even if considered to be combinable, would clearly not result in Applicants' claimed invention. In view of this and in view of the fact that each of the limitations of Claims 2-6 have no corresponding teaching or disclosure in the above-noted references, it is submitted that each of Claims 2-6 also merit indication of allowability.

In view of the foregoing, an early and favorable Office Action is felt to be in order and the same is hereby respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read "J. Maier", with a stylized flourish at the end.

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